

**REMARKS**

Reconsideration of this application is respectfully requested. Claims 24-28 and 35-43 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-5, 7-9, 13-17, 19-30, 35-36, and 39-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable by U.S. Patent Number 6,618,727 B1 by Wheeler et al. (hereinafter "Wheeler") in view of U.S. Patent Number 6,356,899 B1 by Chakrabarti et al. (hereinafter "Chakrabarti"). Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable by Wheeler in view of Chakrabarti as applied to claims 1-5, 7-9, 13-17, 19-30, 35-36, and 39-41 above and in view of U.S. Patent Number 5,675,819 by Schuetze (hereinafter "Schuetze"). Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable by Wheeler in view of Chakrabarti as applied to claims 1-5, 7-9, 13-17, 19-30, 35-36, and 39-41 above and in view of U.S. Patent Number 5,983,216 by Kirsch et al. (hereinafter "Kirsch"). Claims 18, 33, 34, 38, and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable by Wheeler in view of Chakrabarti as applied to claims 1-5, 7-9, 13-17, 19-30, 35-36, and 39-41 above and in view of Agrawal. Claims 31, 32, 37 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable by Wheeler in view of Chakrabarti as applied to claims 1-5, 7-9, 13-17, 19-30, 35-36, and 39-41 above and in view of U.S. Patent Publication Number US20030084040A1 by Jeffrey (hereinafter "Jeffrey").

Office action states that the specification is objected to as failing to provide proper antecedent basis for the claimed subject matter because claim 39, line 2 recites 'machine-readable media.' Claim 39 has been amended to place this claim in a better condition for Appeal. Applicants assert that one skilled in the art would consider a

computing device a machine, and that a computer-readable media fully supports an implementation of a machine readable media. However, applicants assert that reciting computer-readable media in claim 39 does not affect its scope in anyway and complies with/overcomes the Office Action's objection to claim 39.

### ***Claim Rejections - 35 USC § 101***

The office action states:

Claims 24-28 and 35-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C 101.

Claims 24-26 and 35-38 are Apparatus claims. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

It is suggested that the above claims be amended to include hardware components such as a processor or memory to put the claims in the statutory category.

However, the law governing means for claims is very clear and adding hardware components into a means for apparatus claim is not required to satisfy 35 USC 101.

The office action acknowledges that the limitations are recitations of functions, which is all that is required for a claim drafted in the 35 USC 112 paragraph 6 format.

35 USC 112 paragraph 6 itself states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be

construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

The MPEP gives guidance to an Examiner with the following sections.

MPEP 2106 states: "Where means plus function language is used to define the characteristics of a machine or manufacture invention, such language must be interpreted to read on only the structures or materials disclosed in the specification and "equivalents thereof" that correspond to the recited function. Two *en banc* decisions of the Federal Circuit have made clear that the USPTO is to interpret means plus function language according to 35 U.S.C. § 112, sixth paragraph."

MPEP 2111.01 states: "When< an element is claimed using language falling under the scope of 35 U.S.C. 112, 6th paragraph (often broadly referred to as means or step plus function language)\*\* , the specification must be consulted to determine the structure, material, or acts corresponding to the function recited in the claim. *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994)"

MPEP 2181 states: "The Court of Appeals for the Federal Circuit, in its *en banc* decision *In re Donaldson Co.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), decided that a "means-or-step-plus-function" limitation should be interpreted in a manner different than patent examining practice had previously dictated. . . The PTO may not disregard the structure disclosed in the specification corresponding to such [means plus] language when rendering a patentability determination."

The law governing means for claims merely requires the wording in the claim to perform a specified function without the recital of structure. Accordingly, applicants respectfully request the withdrawal of the 35 U.S.C. 101 rejection of claims 24-26 and 35-36.

The office action states that Claim 27-28 and 39-43 are article of manufacture claims, and the claims recite" ... **when** executed by a machine," which is not acceptable. The office action states that "when may not actually . . . happen at all."

"As such, the claims would not be able to perform the step of executing instructions to produce a ranked list of documents and the links to related documents as claimed. Hence, the claims are not statutory because they don't provide a tangible result. To overcome the above rejection, -the word "when" should be removed from the claimed limitations."

However, the law and the Manual of Patent Examining Procedure (M.P.E.P.) § 2106 outlines statutory claim language for software related inventions. In some of the relevant sections, M.P.E.P. § 2106 states:

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 1373, (Fed. Cir. 1998).

patentable subject matter [in] the claims [is] defined [as] "a specific machine to produce a useful, concrete, and tangible result." *In re Alappat*, 33 F.3d 1526, 1544, (Fed. Cir. 1994).

Office personnel should begin their evaluation of a computer-related invention as follows:

- determine what the programmed computer does **when** it performs the processes dictated by the software. (M.P.E.P. § 2106 Patentable Subject Matter - Computer-Related Inventions)

"functional descriptive material" consists of data structures and computer programs which impart functionality **when** employed as a computer component. **When** functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. (MPEP § 2106)

Accordingly, both claims 27 and 39 store functional descriptive material, which imparts functionality **when** employed by a machine. For example, claim 27 states:

An article of manufacture being one or more machine-readable media that store instructions, which when executed by a machine, cause the machine to perform operations comprising:

- generating a list . . .; and
- generating a link . . .

Quoting the above law again "Office personnel should begin their evaluation of a computer-related invention as follows: - determine what the programmed computer does **when** it performs the processes dictated by the software." Accordingly, applicants respectfully request the withdrawal of the 35 U.S.C. 101 rejection of claims 27-28 and 39-43.

Prayer for relief.

Applicants and the examiner have discussed the prior art and the claims of this application for the seventh distinct time. The PTO is supposed to be making a deliberate effort to advance the prosecution of cases. For all of the reasons below, the claims are in a condition for allowance. Attorney for the applicants can be reached at 408-720-8300 if there are some issues left to issue a notice of allowance for these claims.

***Claim Rejections - 35 USC § 103***

The office action states that Claim 1-5, 7-9, 13-17, 19-30, 35-36, are 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler in view of Chakrabarti.

At this point, the office action at least acknowledges that Wheeler does not disclose at least three of the limitations found in claim 1. The office action states:

Applicant argues that 1) Wheeler does not even disclose the

generation of a list of one or more related documents ranked upon relevance to a first representation of content. Wheeler merely discloses the generating of report results in general. 2) There is no disclosure of the report results being presented in the form of a list of ranked documents relevant to a first representation of content. 3) Wheeler also does not teach generating a link to each of the one or more related documents.

In response to the preceding arguments, Examiner respectfully submits that it is recognized that Wheeler does not explicitly teach the above features, as a result, **Chakrabarti** is applied to addressed to argued limitations in this Office Action. And Pitkow was cited in the previous Office Action dated August 4, 2006 to address these limitations. (Office Action dated 1-22-07, page 16)

Yet, the office action goes on then to use Wheeler to satisfy the above third limitation of "Wheeler also does not teach generating a link to each of the one or more related documents," with Wheeler. The office action states: "Regarding claims 1, 13, 21, 24, and 27, Wheeler teaches . . . b). generating a linked to each of the one or more related documents (col. 2, lines 21-26)." Applicants spent 10 pages of point by point explanation in the previous response of how both Wheeler and Pitkow did not disclose these limitations in claim 1 and specifically addressed the [lack of] disclosure in col. 2, lines 21-26 of Wheeler.

Also, the office action cut and pasted Wheeler as disclosing the limitation of weights being associated with each term in a set of term. Applicants spent 10 pages of point by point explanation in the previous response of how both Wheeler and Pitkow also did not disclose this limitation in claim 1 but the current office action does not address or even acknowledge those arguments with regard to the weights being associated with each term in a set of term limitation. Applicant concluded the lengthy discussion about Wheeler by pointing out "Wheeler just does not disclose any limitation in claim 1 or even really any portion of a limitation in claim 1 except

that an XML document may be involved in search (which is still different and does not disclose that content in the XML document may be the content of a query for a search) and should be dropped as discussed piece of prior art.” (Response dated 11-10-2006) Yet, the current office action just pasted in the same paragraph about Wheeler disclosing both the link to a document limitation and the weights to each term limitation and this is after the seventh distinct time of trying to advance the prosecution of this patent application.

Accordingly, applicants will re-duplicate some of those arguments regarding Wheeler’s lack of disclosure.

1) Applicants agree with the Office Action that Wheeler does not disclose generating a list of related documents based upon *relevance to content associated with a first field.*” Also, Wheeler does not even disclose the generation of a list of one or more related documents ranked *upon relevance to a first representation of content.* Wheeler merely discloses a parent-child hierarchy, in which a child category is linked with its corresponding parent category through an entry in a data structure.

2) Wheeler merely discloses the generating of report results in general. There is no disclosure of the report results being presented in the form of a *list of ranked* documents relevant to a first representation of content, an example of which can be seen in Figure 1, item 108 of the specification. Specifically Wheeler states, “A query is the actual search request containing the search criteria. It is usually dynamically specified by the user, but can also be a previously generated stored query. Once the query is entered, the similarity search scores are assigned, the parent scores are computed from their children and report results are generated.” Col. 7, lines 58-63.

Emphasis added. Wheeler, does not further elaborate on the contents of the report results being in the form of a ranked list of relevant documents. Therefore, Wheeler does not disclose even generation of a ranked list of one or more related documents.

Wheeler does not disclose the generation of a list of one or more related documents *ranked upon relevance to a first representation of content from a reference XML document*. In contrast, Wheeler discloses:

a hierarchy of parent and child categories to be searched, linking each child category with its parent category.

(Wheeler, col. 2, lines 11-13)

Creating a hierarchy of parent and child categories further comprises assigning an entry in a data structure... Linking each child category with its parent category further comprises assigning an index to connect each child category with its parent category.

(Wheeler, col. 2, lines 21-26)

Wheeler is directed to detecting and scoring similarities between two or more documents in a source database based on a search criteria. (Wheeler, Abstract.) As stated by the Examiner, "Wheeler displays results of a document comparison similarity search which shows the side by side display of the document comparison search result for two documents." Office Action dated Aug. 10, 2006, page 11. Displaying the results of a document comparison similarity search is not the same as generating a list of one or more related documents ranked based upon relevance to a first representation of content. Wheeler is merely comparing two documents for individual similarities, as shown by the two documents in Figure 25. Wheeler fails to generate a list of related documents *ranked upon relevance to a first representation of content and rather shows similarities between two stored documents*.



3) Wheeler also does not teach generating a link to each of the one or more related documents. Wheeler merely discloses a parent-child hierarchy, in which a child category is linked with its corresponding parent category through an entry in a data structure. Wheeler discloses creating a hierarchy of parent and child categories. (Wheeler, col. 2, lines 20-23.) The parent and child categories include objects identified as parent and child objects. (Wheeler, col. 2, lines 13-17.) In other words, the objects in the source database are arranged in parent and child categories, and each child category has a hierarchical relationship with the a corresponding parent category. Wheeler, col. 7, lines 11-15. The linking described in Wheeler is merely linking each child category with its parent category. (See Wheeler, col. 2, lines 24-26.) In this way, Wheeler merely teaches linking categories, but does not teach generating a link to a particular document.

4) For similar reasoning to that above, Wheeler does not teach generating a link which points to a relevant field within each of the one or more related documents. Wheeler merely discloses links to related categories not documents and not fields within those documents.

5) Wheeler also does not disclose the first representation including a set of terms and one or more weighted values associated with each term in the set of terms as claimed in claim 1. Wheeler states:

Once the query is entered, the similarity search scores are assigned, the parent scores are computed from their children and the report results are generated.

(Wheeler, col. 7, lines 60-63)

As discussed for a previous limitation deficiency, Wheeler is merely discloses that search scores that are assigned to the documents themselves and not weight values

with each term in the set of terms associated with the *representation*. Wheeler discloses that parent scores are computed from their children scores. Nothing in Wheeler discloses the association of one or more weighted values with every term in a set of search terms that forms the basis of the query but rather a scoring system associated with the document itself. Wheeler further states:

The document labeled anchor 340 is the first document in a hierarchical language that is annotated with a scoring method or algorithm (measure), weighting and parent scoring algorithm, the annotated first document becoming a query which is used to search a second document. The score represents the similarity search results as specified by the scoring method for between the objects of the first and second document.

(Wheeler, col. 20, lines 39-47)

Here, Wheeler is only disclosing the use of a weighting system between two documents wherein the first document becomes a query that is used to search a second document. Wheeler is not disclosing, "generating a list of one or more related documents ranked based upon relevance to a ... the first representation that includes a set of terms and one or more weighted values associated with each term." In Wheeler, the entire search query may be assigned a single weighted value, rather than each term within the query having one or more weighted values. Wheeler supports this by stating that each parent/child object may be given a weighting, but not each term with the search query. "The weighting among attributes 73 determines the relative weight to be given to each parent/child object in a search where there are multiple children within a parent object." Col. 11, lines 53-55. Wheeler's disclosed schema specifies the user's search categories, a scoring algorithm used to determine the type of similarity score to be given to the source data objects, a parent score computing algorithm to determine how to compute the similarity scores for parent objects using the scores from the child objects, and a weighting value that determines the relative weight given to child objects that have the same parents. (Wheeler, col. 7, lines 45-54). The schema is used to translate and structure the data in the source database into a hierarchical form having child and parent objects. (Wheeler, col. 7, lines 27-30). Creating a hierarchy of parent

and child categories further comprises assigning an entry in a data structure called a data band to each child category that contains no children categories. (Wheeler, col. 2, lines 21-24). Therefore, Wheeler does not disclose or suggest basing relevance to a first representation that includes a set of terms and one or more weighted values associated with each term.

Therefore, Wheeler does not disclose or suggest the limitations stated in claim 1 and, in fact, explicitly teaches away from the limitations stated in claim 1. The office action in writing acknowledges that Wheeler does not disclose four limitations found in claim 1 and Wheeler clearly does not disclose the weights associated with each term in the set of terms. Wheeler just does not disclose any limitation in claim 1 or even really any portion of a limitation in claim 1 except that an XML document may be involved in search (not that content in the XML document may be the content of a query for a search) and should be dropped as discussed piece of prior art.

Although it is not asserted, applicants' note for the record Chakrabarti also does not disclose both the link to a document limitation and the weights to each term limitation in claim 1.

The office action cites Chakrabarti as teaching 'generating a list of one or more related documents ranked based upon relevance to a first representation of content associated with a first field of a reference XML document.' Yet, Chakrabarti does not disclose that the 'the titles of the pages previously collected ranked by authority weighted and hub weight' are ranked based upon relevance to a first representation of content associated with a first field of a reference XML document. In fact, Chakrabarti actually discloses that it "generates a search query based upon

the category attributes entered at the interface, and the interface has one or more screens, respectively, having one or more partitions, and includes providing at least one partition for enabling modification of category attributes." Chakrabarti, Col. 36 Lns. 5-15. Thus, Chakrabarti does not teach or suggest the limitation of 'generating a list of one or more related documents ranked based upon relevance to a first representation of content associated with a first field of a reference XML document.' Accordingly, Chakrabarti also does not teach or suggest the limitation of 'generating a link to a relevant field within those one or more related documents.'

Thus, for the reasons stated above, Chakrabarti and Wheeler, either alone or in combination, fail to teach or suggest all of the limitations of the claim.

Even if *arguendo* the combination of cited references were to disclose all of the limitations of the claim, the Office Action does not provide a proper motivation to combine the references. First, the motivation suggested by the office action is not found documented in either reference. Applicants assert that one reading Chakrabarti or Wheeler would not find any text suggesting this combination in spite of the Office Action's assertion.

Moreover, the Office Action does not provide a proper motivation to combine the references. Specifically, the Office Action merely restates the advantage of that Chakrabarti is capable of providing alone, which is not readily applicable to Wheeler because Wheeler does not deal with identifying preferred Web pages. Wheeler is applicable to searching objects in a database. In particular, Wheeler does not describe searching the database for identifying preferred Web pages, but rather for

finding documents according to the search query. There is no mention in Wheeler of even the possibility of identifying preferred Web pages, in the content in the database. Therefore, although the Office Action generally asserts that the teaching of Chakrabarti would have allowed Wheeler to "to improve the quality of results returned to users by calculating the overall document relevance to provide a ranking system that performs a ranking based on relevance as determined by improved, automated computation of the link structure between information element" this generic assertion of improved performance is not supported by the differences between the searching applications of Wheeler and Chakrabarti.

In sum, given that the cited references in combination still fail to teach or suggest all of the limitations of claim 1 and the current office action even acknowledges this fact, Applicant respectfully submits that claim 1 is patentable over the cited references. Additionally, the claim is patentable over the cited references because there is the Office Action fails to establish a motivation to combine the references. Accordingly, Applicant requests that the rejection of claim 1 under 35 U.S.C. § 103(a) be withdrawn

Given that claims 2-12 depend from independent claim 1, which is patentable over the cited references, Applicant respectfully submits that dependent claims 2-12 are also patentable over the cited references. Accordingly, Applicant requests that the rejection of claims 1-12 under 35 U.S.C. § 103(a) be withdrawn.

Independent claims 13, 21, 24 and 27 and their respective dependent claims also contain a similar limitation but literally different limitation to "generating a list of

one or more related documents ranked based upon relevance to a first representation of content associated with a first field of a reference extensible markup language document and the link points to a relevant field within each of the one or more related documents." Therefore, independent claims 13, 21, 24 and 27 and their respective dependent claims are patentable over Chakrabarti in combination with Wheeler.

An additional comment on dependent claim 2. Claim 2 states "wherein the first field in the reference extensible markup language document is specified at the time a query is generated." Wheeler Col. 2 lines 42-44 says that one can specify the search criteria at the time of the search. Wheeler is silent about the concept of being able to single out specific fields in a reference XML document as the basis of the query. Singling out specific desired fields allows the user to exclude other content that may interfere with the search pulling back the specific related documents the user is wanting to review by pulling back extra documents to sift through.

An additional comment on dependent claim 3. Claim 3 states " wherein the one or more related documents comprise a first related document having a second field, at the time the query is generated, a user specifies to search content associated with the second field." Wheeler is silent about the concept of being able to single out specific fields in documents to be searched to see if the relevant content is in those fields. A blanket statement that one can specify the search criteria at the time of the search does not disclose or suggest that ability to exclude content from a search so that the retrieved documents are more pertinent to the user's exact request.

In regards to independent claims 29, 35 and 39, the Examiner states Chakrabarti discloses the limitation of, "Executing a query on content from an active desktop window *without a user having to request the query.*" Chakrabarti does not have anything to do with examining the content in the currently active desktop window and automatically suggesting related documents to the content in the active desktop window. Chakrabarti deals with identifying, ranking, and cataloging favorite web pages and that is not even relevant to executing a query on content from an active desktop window *without a user having to request the query.* Independent claim 29 states:

executing a query on the content from an active desktop window without a user having to request the query;  
generating a ranked list of documents related to the content based on the content in the active desktop window; and  
generating links to the documents, wherein the links point to a relevant fields within the documents.

Additionally, as discussed previously above, neither Chakrabarti or Wheeler discloses "generating links to the documents, wherein *the links point to a relevant fields* within the documents."

Independent claims 35 and 39 and their respective dependent claims also contain a similar limitation but literally different limitation to "generating a list of one or more related documents ranked based upon relevance to a first representation of content associated with a first field of a reference extensible markup language document and the link points to a relevant field within each of the one or more related documents." Therefore, independent claims 29, 35, and 39 and their respective dependent claims are patentable over Chakrabarti in combination with Wheeler.

The 35 U.S.C. § 103(a) claim rejections using Schuetze, Kirsch, Agrawal, and/or Jeffrey are deficient as well. None of these references make up for the deficiencies in the disclosures of Wheeler and Chakrabarti discussed above. Therefore, claims 10, 11, 12, 18, 33, 34, 38, 43, and 31, 32, 37, and 42 stand patentable over the cited references of Schuetze, Kirsch, Agrawal, and/or Jeffrey in combination with Wheeler and Chakrabarti.

**CONCLUSION**

It is respectfully submitted that in view of the remarks set forth herein, the rejections have been overcome. If the Examiner believes a telephone interview would expedite the prosecution of this application, the Examiner is invited to contact Tom Ferrill at (408) 720-8300. If there are any additional charges, please charge them to Deposit Account No. 02-2666.

Respectfully submitted,

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